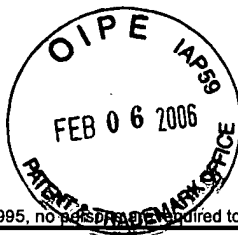


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2500 Div2Con2Div3Con2
(203-3515 Div2Con2Div3Con2)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on February 3, 2006

Signature

Typed or printed
name

Dana A. Brussel

Application Number

10/662,923

Filed

September 15, 2003

First Named Inventor

Peter M. Bonutti

Art Unit

3731

Examiner

Michael H. Thaler

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 45,717

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Telephone number

February 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No. 10/662,923
Communication dated February 3, 2006



City. Docket: 2500 DIV2 CON2 DIV3 CON2
(203-3515 DIV2 CON2 DIV3 CON2)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Peter M. Bonutti

EXAMINER: Thaler, Michael H.

SERIAL NO.: 10/662,923

GROUP UNIT: 3731

FILED: September 15, 2003

DATED: February 3, 2006

FOR: FLUID OPERATED RETRACTORS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW


Sir:

The above-referenced application has been reviewed in light of the Advisory Action mailed November 23, 2005 and the final Office Action mailed August 3, 2005. By the present communication, the Applicant respectfully requests a panel review of the final rejection in the above-identified application. A Notice of Appeal is being filed concurrently with this request.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 3, 2006.

Dated: February 3, 2006


Dana A. Brussel

The Advisory Action maintained the rejection of claims 2, 5, 7-9, and 13. In the Office Action mailed on August 3, 2005, these claims were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 4,655,746 to Daniels et al. (the '746 patent) in view of U.S. Patent No. 5,180,367 to Kontos et al. (the '367 patent). In addition, the Advisory Action maintained the rejection of claims 3 and 4 under 35 U.S.C. § 103 (a) as being unpatentable over the '746 patent in view of the '367 patent and further in view of U.S. Patent No. 4,981,478 to Evard et al. and the rejection of claims 11 and 12 under 35 U.S.C. § 103 (a) as being unpatentable over the '746 patent in view of the '367 patent and further in view of U.S. Patent No. 4,690,140 to Mecca.

However, the Office Action fails to show proper motivation for modifying the device disclosed in the '746 patent using features disclosed in the '367 patent and thereby fails to establish its *prima facie* case for rejecting the claims under 35 U.S.C. § 103 (a).

The '746 patent explicitly discloses a catheter device having first and second balloons, wherein the first and second balloons are inserted into a vessel, axially spaced from one another, and subsequently inflated.¹ By providing this particular configuration, a region in a vessel between the inflated balloons is isolated so that chemical agents may be introduced through an opening in the distal end of the most proximal balloon and directed towards an intended target located between the first and second balloons.

¹ The '746 patent at Column 6, lines 40-47.

Alternatively, this configuration allows occlusion of a specific region in the vessel for treatment of a tumor. Further still, the '746 patent discloses that the distalmost balloon is positionable from a proximal end of the instrument by attaching a guide wire to the distal end of the distalmost balloon.²

The '367 patent discloses a device having first and second balloons wherein the distalmost balloon has an open end and is inflatable through a dual lumen. According to the '367 patent, the open end is adapted for receiving a guidewire therethrough.

The Office Action asserted that it would have been obvious to modify the distalmost balloon of the '746 patent to include an open end as disclosed in the '367 patent. However, this assertion cannot be maintained in view of the '746 patent's disclosure. According to the '746 patent, the guidewire is attached to the distal end of the second balloon using a flexible spring that is "secured to the distal end of bore 70."³ This specific configuration supports the disclosed operation of the device and allows the distalmost balloon to be deployed, positioned, and maneuvered from the proximal end of the instrument.^{4,5} Removing the flexible spring from the distal end of the second balloon as suggested in the Office Action would render the device of the '746 patent inoperable for its stated purpose and undermines the teachings of the '746 patent.⁶

² *Id* at Column 4, lines 52-62.

³ *Id.*

⁴ *Id.*

⁵ *Id* at Column 4, line 63 - Column 5, line 5.

⁶ See page 8 of the Applicant's amendment response mailed on November 3, 2005.

Rather than suggesting the Applicant's recited device, combining the references cited in the Office Action would defeat the teachings of the primary reference (i.e. the '746 patent) and fails to establish its *prima facie* case for obviousness. Since the '746 patent specifically teaches away from an open distal end in the second balloon, there is no suggestion or motivation in either reference to modify the second balloon of the '746 patent to have an open distal end as disclosed in the '367 patent. Further still, since the combination proposed by the Office Action would destroy the teachings of the primary reference, there would be no reasonable expectation of success. Therefore, the Office Action has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 (a).

Respectfully submitted,



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